UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/033,901	02/28/1998	JAMES T. BACHMANN	10980710-1	2649

22878 7590 01/23/2004		EXAMINER
AGILENT TECHNOLOGIES, INC.		LUU, SY D
INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT.		

	ART UNIT	PAPER NUMBER
P.O. BOX 7599	2174	
M/S DL429		/9
LOVELAND, CO 80537-0599		

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*25 September 2003*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

		Application/Control No.	Applicant(s)/Patent Under Reexamination
Notice of References Cited		09/033,901	BACHMANN, JAMES T.
		Examiner	Art Unit	Page 1 of 1
		Sy D Luu	2174	

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,239,800 B1	05-2001	Mayhew et al.	345/764
	B	US-6,286,137 B1	09-2001	Bleizeffer et al.	717/127
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

DETAILED ACTION

1.   In view of the Decision On Appeal sent on 9/25/03, PROSECUTION IS HEREBY

REOPENED.   Upon further updated search and consideration, a new ground of rejection is

made in view of Mayhew et al. as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a

supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or

other evidence are permitted. See 37 CFR 1.193(b)(2).

2.   Claims 1-9 are pending in this application. Claims 1, 4 and 7 are independent claims.

This action is made Non-Final.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   Claims 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter, specifically a software application. It appears that the computer

system programmed to perform the steps as recited in claim 7 fails to be tangibly embodied on a

computer readable medium so as to be executable. Computer programs claimed as computer code per se, i.e., the descriptions or expressions of the programs, are not physical "things," nor are they statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program's functionality to be realized. In contrast, a claimed computer - readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. See MPEP §2106 Section IV.B.1(a).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson et al. ("Wilson", US 5,392,207).

As per claims 1, Wilson teaches, in an iconic programming system containing an existing network of connected icons (col. 2, lines 38-42), a computer-implemented method for tracing the execution of icons (**fig. 5**, col. 4, lines 29-32; col. 5, lines 53-55), the method comprising the step of: executing a plurality of the icons (**fig.4**; col. 2, lines 38-43); highlighting the icon which is currently being executed on the display (**fig. 4**, col. 9, lines 58-60).

Wilson, however, does not explicitly disclose the steps of setting a flag for each icon being executed, thereby highlighting each icon being set by its corresponding flag. However, these steps must necessarily be <u>inherent</u> to such a method as Wilson's so as to provide the method a means for determining and keeping track of the execution status of each icon by setting a "True" indication to a "True/False" flag that is associated to each icon being executed; thereby providing the method necessary status information to properly determine and display the highlighting of the plurality of icons.

As per claims 2-3, Wilson does not explicitly disclose the steps of: performing the setting step during the executing step, receiving an input subsequent to the executing step, and performing the determining step in response to the receiving step. However, these steps, which work in conjunction with the flags, must also be necessarily <u>inherent</u> to Wilson's method for the same reasons as provided in the previous paragraph.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

8.   Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayhew et al.

("Mayhew", US 6,239,800 B1).

As per claim 1, Mayhew teaches, in an iconic programming system containing an

existing network of connected icons (**fig. 6**), a computer-implemented method for tracing the

execution of icons (**abstract**), the method comprising the step of:

executing a plurality of the icons (col. 2, lines 14-22); and

· highlighting each icon executed in the executing step (**figs. 6-7**; col. 4, lines 46-58; col. 5,

lines 2-6).

Mayhew does not explicitly disclose the steps of setting a flag for each icon executed,

thereby highlighting each icon being set by its corresponding flag. However, these steps must

necessarily be <u>inherent</u> to such a method as Mayhew's so as to provide the method a means for

determining and keeping track of the execution status of each icon by setting a "True" indication

to a "True/False" flag that is associated to each executed icon during the executing step; thereby

providing the method necessary status information to properly determine and display the

highlighting of the plurality of icons.

As per claims 2-3, Mayhew does not explicitly disclose the steps of: performing the

setting step during the executing step, receiving an input subsequent to the executing step, and

performing the determining step in response to the receiving step. However, these steps, which

work in conjunction with the flags, must also be necessarily <u>inherent</u> to Mayhew's method for the same reasons as provided in the previous paragraph.

As per claim 4, Mayhew teaches, in an iconic programming system, wherein the iconic programming system contains an existing network of connected icons (**fig. 6**), a computer-implemented method for tracing the execution of icons (**abstract**), the method comprising the step of:

executing a plurality of the icons (col. 2, lines 14-22);

indicating which of the icons are executed in the executing step,

determining, subsequent to the executing step and based on the indicating step, that the plurality of icons have been executed, and

highlighting the plurality of executed icons in response to the determining step (**figs. 6-7**; col. 4, lines 46-58; col. 5, lines 2-6).

As per claim 5-6, the method of Mayhew does not explicitly disclose the steps of: setting, during the executing step, a plurality of flags respectively corresponding with the plurality of icons; receiving an input subsequent to the executing step, and performing the determining step in response to the receiving step.

However, these steps must be <u>inherent</u> to such a method as Mayhew's so as to provide the method a means for determining and keeping track of the execution completion status of each icon by setting a "True" indication to a "True/False" flag that is associated to each executed icon during the executing step; thereby providing the method necessary status information to properly determine and display the highlighting of the plurality of icons.

Claims 7-9 are similar in scope to claim 4-6, and therefore are rejected under similar

rationale.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Bleizeffer et al. (US 6,286,137 B1) teaches a method of indicating steps in a task which

have been completed.

Inquires

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sy Luu whose telephone number is **(703) 305-0409**. The

examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The

examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned is

(703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

SY D. LUU
PRIMARY EXAMINER

MARGARET A. FOCARINO
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